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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,519	11/03/2003	Minoru Chida	244606US0	1401
22850	7590	01/23/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			KRUER, KEVIN R	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	

1773

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/698,519

Applicant(s)

CHIDA ET AL.

Examiner

Kevin R. Kruer

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED December 22, 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 1103 5103/04
13. ☐ Other: _____.

Advisory Action

Applicant's arguments filed December 22, 2005 have been fully considered, but are not persuasive.

Applicant argues the primary reference, Odashima et al, does not describe several limitations in the claimed invention. For instance, the reference does not describe, "that the hydroxyl group containing organic resin should comprising an ionomer," "that the resinous coating should comprise ammonium vanadate," or that the "steel sheet should be galvanized." The examiner agrees but took the position that one of ordinary skill in the art would have been motivated to modify the teachings of Odashima in order to teach said limitations in order to improve the corrosion resistance of the laminate, as motivated by Applicant's admissions and Morishita. According to applicant, one of ordinary skill in the art would not have been motivated to improve the corrosion resistance of the laminate taught in Odashima because the laminate of Odashima already is taught in possess excellent corrosion resistance (col 1, lines 60-63). The argument has been fully considered but is not persuasive because the primary reference need not explicitly state a deficiency in order to one of ordinary skill in the art to be motivated to modify the teachings of said reference. Rather, the prior art as a whole must suggest that the proposed modification is desirable. In the present applicant, Applicant's admissions and Morishita teach the proposed modifications are desirable in order to improve the laminate's corrosion resistance.

Applicant further argues there is no suggestion to use silica at the exclusion of any of the other several oxides materials disclosed in Odashima. The examiner

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respectfully disagrees. Odashima teaches silica is the preferred colloid or powder (col 11, lines 40+).

Applicant notes, and the examiner acknowledges, that Odashima teaches steel substrates, but does not teach the use of hot dip galvanized steel substrates. In order to make up for said deficiency, the examiner relied upon applicant's admissions, which states that steel sheets are in many cases hot dip galvanized at their surface in order to ensure corrosion resistance (bottom of page 1 of the specification). Applicant has not explained how the examiner erred in this determination of obviousness. The rejection is, therefore, maintained.

Applicant further argues Zn-electroplated steel substrates are taught as the preferred substrate in Odashima whereas the current invention teaches corrosion resistance is not exhibited if Zn-electroplated steel substrates are utilized. The examiner notes that Odashima may be relied upon for all that it reasonably teaches and is not limited to preferred embodiments or disclosed examples. Thus, the teachings of Odashima are not limited to Zn-electroplated steel substrates. If applicant is attempting to establish a showing of unexpected results with regards to the substrate utilized, the examiner notes the specification contains no data that demonstrates hot dip galvanized steel substrates exhibit an unexpected improvement over Zn-electroplated steel substrates.

With regards to the organic resin utilized in Odashima, Applicant argues there is no description whatsoever of a polyolefin copolymer molecular associated by ion clusters. The examiner agrees, but notes Odashima was never relied upon for such a

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teaching. Rather, Morishita was relied upon to teach the claimed resin. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With regards to the Morishita reference, Applicant notes there is no evidence that modifying the composition of Odashima with an ionomer would be effective. The examiner acknowledges that there is no explicit suggestion that the use of the ionomeric resin taught in Morishita in the composition taught in Odashima would be effective. However, the examiner maintains the rejection because one of ordinary skill in the art, given the teachings of both reference, would have had a reasonable expectation of success if the proposed modification were made. Specifically, Morishita teaches ionomers may be utilized in corrosion resistant coatings, such as the coating taught in Odashima, due to their excellent storage stability, solvent resistance, deep drawing nature, alkali resistance, coating adhesion, and corrosion resistance (0008).

With regards to the Shimizu reference, Applicant argues the steel sheet taught therein is chromate treated and would not be combined with either Odashima or Morishita because each of said references teaches away from the use of any chromate treatment. Said argument is noted, but is not persuasive because the teachings of Shimizu with regards to surface roughness, as relied upon by the examiner, are independent from the surface treatment utilized. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking

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references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With regards to the Dalton reference, Applicant argues said reference would not cure the deficiencies of Odashima and Morishita since said references teach away from the inclusion of the compounds utilized in the coatings taught in Dalton. Said argument has been fully considered but is not persuasive because the teachings for which Dalton was relied upon (the neutralization of acrylics with amines) would not be contradictory to any of the teachings of Odashima and Morishita. Therefore, the rejection is maintained.

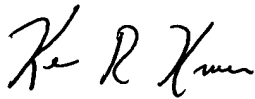
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Kevin R. Kruer". The signature is fluid and cursive, with the first letters of each word being capitalized and prominent.

Kevin R. Kruer
Patent Examiner-Art Unit 1773